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Applicant : William T. Graushar, et al.  
  
Filed : December 29, 2003  
Title : METHOD AND APPARATUS  
FOR ASSEMBLING  
PERSONALIZED  
ELECTRONIC MEDIA INTO  
PRINTED PRODUCTS

I, Mary A. Hietpas, hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Mary A. Hietpas  
Signature  
December 21, 2005  
Date of Signature

TC/A.U. : 3651  
Examiner : Patrick Hewey Mackey

Docket No. : 077047-9410-02

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### **AMENDED APPEAL BRIEF**

Sir:

Applicants have appealed from the decision dated April 21, 2005 of the Examiner finally rejecting Claims 1-4, 6-9, 11-14, and 21-22. This Amended Appeal Brief is submitted in response to the Notification of Non-Compliant Appeal Brief mailed December 5, 2005, and is filed within the one-month period for response. Applicants' attorney timely filed a Notice of Appeal on July 21, 2005 and corresponding Appeal Brief on October 25, 2005. Charge or credit Deposit Account No. 13-3080 with any shortage or overpayment of the fees associated with this Amended Appeal Brief.

#### **I. REAL PARTY IN INTEREST**

The real party in interest is Quad/Graphics, Inc., N63 W23074 Main Street, Sussex, Wisconsin 53089.

## II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interference proceedings in process that would directly affect or be directly affected by the Board's decision.

## III. STATUS OF CLAIMS

Claims 1-22 are pending. Claims 5, 10, and 15-20 have been withdrawn by the Examiner. Claims 1-4, 6-9, 11-14, and 21-22 stand finally rejected and appealed.

## IV. STATUS OF AMENDMENTS

Applicants have not made any amendments after final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

### A. General Context of Embodiments of the Applicants' Invention

The Applicants developed a method and apparatus for the production of print media such as magazines, catalogs, pamphlets and envelopes that include electronic media, such as DVDs, CDs, and cards which include magnetic strips, and more particularly to printed media that includes CDs with personalized information. Specification, page 1, lines 10-14.

The method of the present invention includes reading and/or writing personalized information from/to a data storage device and assembling the data storage device within a printed product that is to be delivered to a particular individual. Specification, page 2, lines 13-16.

### B. Independent Claim 1

Independent Claim 1 is directed to a method comprising the acts of writing electronic information to an optical disk on a binding line (Specification, page 5, line 32-page 6, line 2; page 6, lines 14-16; page 7, lines 22-30; Fig. 1, CD writing machine 20); and associating the written optical disk with a printed product on the binding line (Specification, page 6, lines 9-11; page 7, lines 25-28; page 8, lines 21-23; page 9, lines 1-5 and 10-14).

### C. Independent Claim 6

Independent Claim 6 is directed to a method comprising the acts of reading electronic information from an optical disk on a binding line (Specification, page 7, lines 10-16 and lines 28-30; page 8, lines 20-30; page 9, lines 1-7 and lines 11-14); and associating the optical disk

with a printed product on the binding line (Specification, page 6, lines 9-11; page 7, lines 25-28; page 8, lines 21-23; page 9, lines 1-5 and 10-14).

D. Independent Claim 11

Independent Claim 11 is directed to a method comprising the acts of reading electronic information from an optical disk on a binding line wherein the optical disk has been electronically written offline with respect to the binding line (Specification, page 4, lines 7-11; page 6, lines 3-7); and associating the optical disk with a printed product on the binding line (Specification, page 6, lines 9-11; page 7, lines 25-28; page 8, lines 21-23; page 9, lines 1-5 and 10-14).

E. Independent Claim 21

Independent Claim 21 is directed to a method comprising the acts of writing electronic information to an optical disk on a binding line (Specification, page 5, line 32-page 6, line 2; page 6, lines 14-16; page 7, lines 22-30; Fig. 1, CD writing machine 20); delivering a plurality of printed products to the binding line based upon the information written to the optical disk (Specification, page 9, lines 10-14); and associating the printed product and the optical disk on the binding line (Specification, page 6, lines 9-11; page 7, lines 25-28; page 8, lines 21-23; page 9, lines 1-5 and 10-14).

F. Independent Claim 22

Independent Claim 22 is directed to a method comprising the acts of reading electronic information from an optical disk on a binding line (Specification, page 7, lines 10-16 and lines 28-30; page 8, lines 20-30; page 9, lines 1-7 and lines 11-14); delivering a plurality of printed products to the binding line based upon the information read from the optical disk (Specification, page 8, lines 20-27); and associating the printed product and the optical disk on the binding line (Specification, page 6, lines 9-11; page 7, lines 25-28; page 8, lines 21-23; page 9, lines 1-5 and 10-14).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1, 3, 6, and 21-22 are unpatentable under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,388,815 ("Hill '815")?

2. Whether Claims 11, 13-14, and 22 are unpatentable under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,431,453 ("Hill '453")?

3. Whether Claims 1-3, 6-7, and 21-22 are unpatentable under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,126,201 (“Pace”) in view of Hill ‘815?

4. Whether Claims 4 and 8-9 are unpatentable under 35 U.S.C. § 103 as being obvious over Pace in view of Hill ‘815 and further in view of U.S. Patent No. 5,114,128 (“Harris”)?

5. Whether Claim 12 is unpatentable under 35 U.S.C. § 103 as being obvious over Hill ‘453 in view of Harris?

## VII. ARGUMENT

### A. The Law Governing Claim Rejections Under 35 U.S.C. § 102

To prove a *prima facie* case of anticipation, the Examiner must show that each and every element as set forth in the claim is either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131.

### B. The Law Governing Claim Rejections Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q. 871, 881 (CCPA 1981). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); M.P.E.P. §§ 706.02(j), 2143.03.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art

reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); In re Vaeck, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442; M.P.E.P. § 2143. The Examiner can only establish a *prima facie* case of obviousness by pointing out some objective teaching in the prior art references themselves that would lead one of ordinary skill in the art to combine the relevant teachings and the references. In re Fine, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1598-99; In re Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); M.P.E.P. § 2143.01.

In addition, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127; M.P.E.P. § 2143.01.

C. The References

1. U.S. Patent No. 5,388,815 ("Hill '815")

Hill '815 discloses a credit card package production system 10 that produces embossed and encoded credit cards 30 mounted to carrier forms 26. The system 10 includes an embosser section 20 and an inserter section 24. The embosser section 20 embosses alphanumeric characters 32 on the face of the card 30 and magnetically encodes information on a magnetic stripe 35 on the back of the card 30.

A bar code 27 is used to encode the card account information printed on the carrier forms 26. Once the carrier forms 26 are printed, the forms 26 are sent to a form burster 36. The form burster 36 carries a sensor for reading the code 27 from each carrier form 26. The inserter section 24 inserts the embossed and encoded cards 30 into the printed carrier forms 26. If the information embossed on the card 30 is not correctly prepared or does not match the associated

carrier form 26, the card 30 is rejected. Alternatively, preprinted carrier forms with the preprinted carrier account data are sent directly to a form bar code reader 38 and are used for receipt of embossed cards 30.

2. U.S. Patent No. 6,431,453 ("Hill '453")

Hill '453 discloses a smart card verification system 10 for inserting smart cards 30 into corresponding carriers 50 after verifying the card data with a magnetic stripe reader 72, an embossed character reader 74, and IC chip reader 64, a first bar code reader 68 and a back bar code reader 70 with data encoded on the printed carrier 50 that is read with a carrier reader 106. The information is then compared with account data stored in a smart card account data memory 67. If the information does not match, the card is rejected.

At a first reading station 82, the magnetic strip reader 72 and embossed character reader 74 verify the information on the card. If there is a match between the account information from the stripe reader 72 and the character reader 74, a verification controller 66 polls carrier print information from the card and uses the information to control a form printer to print carrier account information on the carriers 50. The card then passes to a second read station including the IC chip reader 64. The information from the chip reader 64 is then compared to the information read from the strip reader 72 and the character reader 74 to determine if there is a match. If so, the card moves to a third reading station including the bar code readers 68, 70. All of the data is compared to determine a match.

3. U.S. Patent No. 6,126,201 ("Pace")

Pace discloses a folder 50 for holding a compact disc in a position for binding the folder 50 into a magazine. The folder includes a compact disc assembly 80 having a planar base portion 82, a compact disc 52 supported on one surface 83 of the base portion, and a covering 84. Once the compact disc 52 is positioned within the folder 50, the folder is forwarded to other manufacturers for processing. At no point is information read from or written to the CD in the process disclosed in Pace.

4. U.S. Patent No. 5,114,128 ("Harris")

Harris discloses a method and apparatus for incorporating pre-personalized signatures within magazines and books. A pre-personalized signature 16a is deposited on a chain 12, and a bar code reader 58 reads a bar code. The bar code information is transmitted to an ink jet printer to print name and address information to a magazine cover (see Col. 9, lns. 11-22). The

personalized signature is part of the printed product and does not require being associated with another printed product.

D. Claims 1, 3, 6, and 21-22 Are Not Anticipated By Hill '815 Under 35 U.S.C. §  
102

1. Claim 1

Independent Claim 1 defines a method comprising the acts of writing electronic information to an optical disk on a binding line and associating the written optical disk with a printed product on the binding line.

Hill '815 does not teach or suggest the subject matter of Claim 1. Hill '815 does not teach or suggest writing electronic information to an optical disk on a binding line. Rather, Hill '815 is directed to a card packaging system, where encoded and embossed magnetic credit cards are inserted into carrier forms. The packaging system of Hill '815 is not designed for use with, nor does Hill '815 teach using an optical disk as recited in Applicant's independent claim 1. On page 2, paragraph 2 of the final Office Action, the Examiner identifies reference numeral 36 as being an optical disk. A review of the Hill '815 specification reveals that reference numeral 36 refers to a form burster that carries a sensor for reading a code printed on each carrier form (see Col. 6, lines 10-16). Applicant respectfully submits that the form burster identified by the Examiner is not an optical disk and is in no way equivalent to the optical disk recited in claim 1.

The term "optical disk" as defined in Applicants' patent application refers to storage devices such as CDs and DVDs (see pg. 5, lines 11-12). Applicant further differentiates an optical disk from other storage devices such as magnetic media (including floppy disks or cassette tapes) and cards having magnetic strips (see pg. 5, lines 12-13). Thus, Applicants respectfully disagree with the Examiner and submit that nothing in Hill '815 teaches or suggests a method including writing electronic information to an optical disk as there is no optical disk component of the Hill '815 system.

For at least the reasons noted above, Hill '815 does not teach or suggest the subject matter of Claim 1. Accordingly, independent Claim 1 is allowable.

2. Claim 3

Claim 3 further specifies the act of printing personalized indicia on the printed product in response to what was written to the optical disk. As discussed above with respect to Claim 1, Hill '815 does not teach or suggest the subject matter of Claim 3.

Hill '815 also does not teach or suggest the act of printing personalized indicia based on what was written to the optical disk. Rather, Hill '815 discloses a verification step. Hill '815 prints the carrier form independently of the encoding of the card, and then later, downstream of the encoding, simply verifies that the card and carrier form contain matching information. The carrier form is not printed based on any information on the card. As stated in claim 3, the method of the present invention actually utilizes the information written to the disk to print the personalized indicia on the signature.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of Claim 3. Accordingly, Claim 3 is allowable.

3. Claim 6

Independent Claim 6 defines a method including the acts of reading electronic information from an optical disk on a binding line, and associating the optical disk with a printed product on the binding line.

As discussed above with respect to Claim 1, Hill '815 does not teach or suggest the subject matter of independent Claim 6. Hill '815 simply does not teach or suggest any action upon or gathering information from an optical disk for any purpose.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of Claim 6. Accordingly, independent Claim 6 is allowable.

4. Claim 21

Independent Claim 21 defines a method comprising the acts of writing electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information written to the optical disk, and associating the printed products and the optical disk on the binding line.

As discussed above with respect to Claim 1, Hill '815 does not teach or suggest the subject matter of independent Claim 21. In addition to the arguments set forth above, Hill '815 does not teach or suggest the act of delivering a plurality of printed products to the binding line based upon information written to an optical disk. As discussed above, magazines are often personalized to the recipient based upon the combination of signatures delivered to the binding



line (i.e., selective binding). There is no teaching or suggestion of this type of personalization through selection of printed products to be delivered to a binding line in Hill '815 and thus Hill '815 does not teach or suggest the elements of the claim.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of Claim 21. Accordingly, independent Claim 21 is allowable.

5. Claim 22

Independent Claim 22 defines a method comprising the acts of reading electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line.

As discussed above with respect to Claim 1, Hill '815 does not teach or suggest the subject matter of independent Claim 22. In addition to the arguments set forth above, Hill '815 does not teach or suggest the act of delivering a plurality of printed products to the binding line based upon information read from an optical disk. As discussed above, magazines are often personalized to the recipient based upon the combination of signatures delivered to the binding line (i.e., selective binding). There is no teaching or suggestion of this type of personalization in Hill '815, and thus Hill '815 does not teach or suggest the elements of the claim.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of Claim 22. Accordingly, independent Claim 22 is allowable.

E. Claims 11, 13-14, and 22 Are Not Anticipated By Hill '453 Under 35 U.S.C. § 102

1. Claims 11 and 13-14

Independent Claim 11 defines a method comprising the acts of reading electronic information from an optical disk on a binding line, wherein the optical disk has been electronically written offline with respect to the binding line, and associating the optical disk with a printed product on the binding line.

Hill '453 does not teach or suggest reading electronic information to an optical disk on a binding line. Rather, Hill '453 is directed to a smart card verification and insertion system utilizing multiple card readers. The system of Hill '453 is not designed for use with, nor does Hill '453 teach using, an optical disk as specified in independent Claim 11. On page 2, paragraph 2 of the final Office Action, the Examiner rejected Claim 11 based upon Hill '453 but

failed to identify the optical disk in the Hill '453 reference. Hill '453 discloses a card insertion system that utilizes a magnetic strip reader 72, an embossed character reader 74, an IC chip reader 64, and bar code readers 68, 70 all which verify information programmed onto and embossed into the card 30. Once the information is verified, the card 30 is inserted into a carrier 50. There is neither use of nor teaching of an optical disk in the system of Hill '453.

As discussed above, the term "optical disk" as defined in Applicants' patent application refers to storage devices such as CDs and DVDs (Specification, page 5, lines 11-12). Applicants further differentiate an optical disk from other storage devices such as magnetic media (including floppy disks or cassette tapes) and cards having magnetic strips (Specification, page 5, lines 12-13). Thus, Applicants respectfully disagree with the Examiner and submit that nothing in Hill '453 teaches or suggests a method including writing electronic information to an optical disk as there is no optical disk component of the system of Hill '453.

For at least these reasons, Hill '453 does not teach or suggest the subject matter defined by Claim 11. Accordingly, independent Claim 11 is allowable. Claims 13 and 14 depend from Claim 11, and are therefore allowable for at least the reasons Claim 11 is allowable.

## 2. Claim 22

Independent Claim 22 defines a method comprising the acts of reading electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line.

As discussed above with respect to Claim 11, Hill '453 does not teach or suggest the subject matter of independent Claim 22. Hill '453 simply does not teach a method as claimed in Claim 22 where information is read from an optical disk, nor does Hill '453 teach delivery of printed products to a binding line based upon information read from an optical disk. As discussed above, magazines are often personalized to the recipient based upon the combination of signatures delivered to the binding line (i.e., selective binding). There is no teaching or suggestion of this type of personalization in Hill '453, and thus Hill '453 does not teach or suggest the elements of the claim.

For at least these reasons, Hill '453 does not teach or suggest the subject matter of Claim 22. Accordingly, independent Claim 22 is allowable.

F. Claims 1-3, 6-7, and 21-22 Are Not Obvious In View of Pace and Hill '815 Under 35 U.S.C. § 103

1. Claims 1-2

Independent Claim 1 defines a method including writing electronic information to an optical disk on a binding line, and associating the written optical disk with a printed product on the binding line.

As acknowledged by the Examiner on page 3, paragraph 5 of the Office Action mailed April 21, 2005, Pace discloses a method for associating a CD with a printed product, but does not disclose writing electronic information on a binding line. The Examiner goes on to suggest that Hill '815 discloses writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner, such that it would have been obvious for a person of ordinary skill in the art at the time of the invention to modify Pace by writing electronic information on a binding line for the purpose of delivering owner specific electronic media to the account owner, and cites specifically to Hill '815, col. 7, lines 4-20 for providing the motivation to combine (see page 5, paragraph 16 of the Office Action mailed April 21, 2005). Applicant respectfully disagrees and submits that the Examiner has failed to make a *prima facie* case of obviousness.

Pace discloses to a method of associating a CD with a printed product, including placing a CD into a package that is glued to a folder, which can then be bound into a printed publication. The CD is preprinted, and Pace does not teach or suggest reading or writing information onto the CD while the CD is on the binding line. In fact, once the CD 52 is positioned within the folder 50, information cannot be written to or read from the CD. The folder is forwarded to other manufacturers for processing. There is no suggestion to verify the information on the CD prior to inserting the folder 50 in a signature, nor is there any suggestion to verify the information on the CD at any time during the associating process. The Examiner has failed to show any motivation in the references to modify the method of Pace such that information is written to the CD while on the binding line. The Pace method is for packaging a CD for insertion into a signature regardless of the information contained on the CD and there is no suggestion in Pace to modify the process to write the information on the binding line.

Hill '815 does not cure the deficiencies of Pace. There is no teaching or suggestion to utilize the method of Hill '815 with an optical disk, as discussed above. The Examiner cites col.

7, lines 4-20 of Hill '815 as motivation to modify the device and method of Pace. A review of the cited passage reveals that a critical feature of the Hill '815 system is the verification process to ensure that only correctly embossed and encoded cards are attached to matching carrier forms, and further discusses four separate verification processes that are performed on the cards and the carrier forms. Pace does not require verification, nor does anything in the Pace reference suggest the desirability of implementing a verification process where information is written to the disk on the binding line and then verified for accuracy. There is simply no suggestion to modify Pace as suggested by the Examiner except in Applicants' own disclosure.

Further, as discussed above, the Pace system as taught in the Pace reference would be unable to write information to a disk on the binding line, but rather is designed to package pre-written CDs. To configure the Pace system to be able to write information onto the disks on the binding line, as recited in Claim 1, would require a complete redesign of the Pace system, which is simply not taught by either Pace or Hill '815.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter defined by Claim 1. Accordingly, independent Claim 1 is allowable. Claim 2 depends from Claim 1 and is allowable for at least the reasons Claim 1 is allowable.

2. Claim 3

Claim 3 further specifies the act of printing personalized indicia on the printed product in response to what was written to the optical disk. As discussed above with respect to Claim 1, Pace and Hill '815 do not teach or suggest the subject matter of Claim 3.

In addition to the arguments set forth above, Hill '815 does not teach or suggest the act of printing personalized indicia based on what was written to the optical disk. Rather, Hill '815 discloses a verification step. Hill '815 prints the carrier form independently of the encoding of the card, and then later, downstream of the encoding, simply verifies that the card and carrier form contain matching information. The carrier form is not printed based on any information on the card. As stated in Claim 3, the method of the present invention actually utilizes the information written to the disk to print the personalized indicia on the signature. Thus, the combination of Pace and Hill '815 fails to teach each and every element of Claim 3.

For at least these reasons, Pace and Hill '815 do not teach or suggest the subject matter of Claim 3. Accordingly, Claim 3 is allowable.

3. Claims 6-7

Independent Claim 6 defines a method including the acts of reading electronic information from an optical disk on a binding line, and associating the optical disk with a printed product on the binding line.

As discussed above with respect to Claim 1, Pace and Hill '815 do not teach or suggest the subject matter of independent Claim 6. Not only is there no teaching or suggestion in Pace to write electronic information to the disk while the disk is on the binding line, there is also no teaching or suggestion of reading any information from the disk on the binding line. In fact, once the CD is packaged within the folder, information cannot be read from the CD any longer. There is no suggestion within the references as to why a modification to the Pace system would be necessary to allow for reading of the information on the CD for verification and/or printing purposes as the Pace system is designed for use with preprinted CDs containing only generic information that need not be verified. There is simply no motivation to combine the references, as suggested by the Examiner, outside of Applicants' own disclosure.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter of Claim 6. Accordingly, independent Claim 6 is allowable. Claim 7 depends from Claim 6 and is therefore allowable for at least the reasons Claim 6 is allowable.

4. Claim 21

Independent Claim 21 defines a method comprising the acts of writing electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information written to the optical disk, and associating the printed products and the optical disk on the binding line.

As discussed above with respect to Claim 1, Pace and Hill '815 do not teach or suggest the subject matter of independent Claim 21. In addition to the arguments set forth above, neither Pace nor Hill '815 teach or suggest the act of delivering a plurality of printed products to the binding line based upon information written to an optical disk. Pace merely positions a disk in a folder regardless of what information is contained on the disk, and Hill '815 only matches the embossed and encoded card with the carrier form, which already exists on the system 10. There is simply no motivation to modify the system of Pace as suggested by the Examiner other than Applicants own disclosure.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter of Claim 21. Accordingly, independent Claim 21 is allowable.

5. Claim 22

Independent claim 22 recites a method comprising the acts of reading electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line.

As discussed above with respect to Claim 1, Pace and Hill '815 do not teach or suggest the subject matter of independent Claim 22. In addition to the arguments set forth above, neither Pace nor Hill '815 teaches or suggests delivering a plurality of printed products to the binding line based upon information read from an optical disk. Pace merely positions a disk in a folder regardless of what information is contained on the disk, and Hill '815 only matches the embossed and encoded card with the carrier form, which already exists on the system 10. There is simply no motivation to modify the system of Pace as suggested by the Examiner other than Applicants' own disclosure.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter of Claim 22. Accordingly, independent Claim 22 is allowable.

G. Claims 4 and 8-9 Are Not Obvious In View of Pace, Hill '815, and Harris Under 35 U.S.C. § 103

1. Claim 4

Claim 4 further specifies that the act of printing personalized indicia occurs after associating the optical disk with the printed product.

As acknowledged by the Examiner on page 3, paragraph 6 of the Office Action mailed April 21, 2005, Pace and Hill '815 do not disclose printing personalized indicia in response to what was read from the optical disk after associating. Harris does not cure the deficiencies of Pace and Hill '815.

Harris does not teach or suggest the act of printing personalized indicia on the printed product after associating the optical disk with the printed product. Rather, Harris discloses that a pre-personalized signature 16a is deposited on the chain 12 and a bar code reader 58 reads a bar code. The bar code information is then transmitted to an ink jet printer to print the name and address information to a magazine cover. The personalized signature is part of the printed product and is not associated with any other printed products. Thus, the combination of references does not teach or suggest the subject matter of Claim 4.

Further, Harris cannot be combined with Pace as Harris requires the ability to read a bar code in order to instruct a downstream printer to print appropriate information. The disk in Pace is enclosed within the folder such that information cannot be read from or written to it. The Examiner has failed to set forth a *prima facie* case as there is no motivation to combine the references, as suggested by the Examiner, other than in Applicants' own disclosure. Thus, the combination of references is improper.

For at least these reasons, the combination of Pace, Hill '815, and Harris does not teach or suggest the subject matter of Claim 4. Accordingly, Claim 4 is allowable.

2. Claim 8

Claim 8 further specifies that the act of printing personalized indicia on the printed product is in response to what was read from the optical disk. As discussed above with respect to Claim 4, Pace and Hill '815 do not teach or suggest the subject matter of Claim 8.

Harris does not cure the deficiencies of Pace and Hill '815. Harris does not teach or suggest the act of printing personalized indicia on the printed product in response to what was read from the disk. Harris discloses that a pre-personalized signature is deposited on the chain 12 and a bar code reader reads a bar code on the pre-personalized signature. The bar code information is transmitted to an ink jet printer to print name and address information to a magazine cover. The personalized signature is not an optical disk and is part of the printed product such that it does not require being associated with the printed product.

In addition, there is no motivation or suggestion to combine the references. Harris cannot be combined with Pace as Harris requires the ability to read a bar code in order to instruct a downstream printer to print appropriate information. The disk in Pace is enclosed within the folder such that information cannot be read from or written to it. The Examiner has failed to set forth a *prima facie* case as there is no motivation to combine the references, as suggested by the Examiner, other than in Applicants' own disclosure. Thus, the combination of Pace, Hill '815, and Harris is improper.

For at least these reasons, the combination of Pace, Hill '815, and Harris does not teach or suggest the subject matter of Claim 8. Accordingly, Claim 8 is allowable.

3. Claim 9

Claim 9 further specifies that the act of printing personalized indicia occurs after associating the optical disk with the printed product. As discussed above with respect to Claim 4, Pace and Hill '815 do not teach or suggest the subject matter of Claim 9.

Harris does not cure the deficiencies of Pace and Hill '815. Harris does not teach or suggest the act of printing personalized indicia on the printed product after associating the optical disk with the printed product. Rather, Harris discloses that a pre-personalized signature 16a is deposited on the chain 12 and a bar code reader 58 reads a bar code. The bar code information is then transmitted to an ink jet printer to print the name and address information to a magazine cover. The personalized signature is part of the printed product and is not associated with any other printed products. Thus, the combination of references does not teach or suggest each and every element of Claim 9.

Further, Harris cannot be combined with Pace as Harris requires the ability to read a bar code in order to instruct a downstream printer to print appropriate information. The disk in Pace is enclosed within the folder such that information cannot be read from or written to it. The Examiner has failed to put forth the *prima facie* case as there is no motivation to combine the references, as suggested by the Examiner, other than in Applicants' own disclosure. Thus, the combination of references is improper.

For at least these reasons, the combination of Pace, Hill '815, and Harris does not teach or suggest the subject matter of Claim 9. Accordingly, Claim 9 is allowable.

H. Claim 12 Is Not Obvious In View of Hill '453 and Harris Under 35 U.S.C. § 103

Claim 12 further specifies that the act of printing personalized information on the printed product is in response to what was read from the optical disk. As acknowledged by the Examiner on page 3, paragraph 7 of the Office Action mailed April 21, 2005, Hill '453 does not disclose printing personalized indicia in response to what was read from the optical disk after associating. Harris does not cure the deficiencies of Hill '453.

Harris does not teach or suggest the act of printing personalized indicia on the printed product in response to what was read from the disk. Rather, Harris discloses that a pre-personalized signature is deposited on the chain 12 and a bar code reader reads a bar code on the pre-personalized signature. The bar code information is transmitted to an ink jet printer to print name and address information to a magazine cover. The personalized signature is not an optical



disk and is part of the printed product such that it does not require being associated with the printed product.

In addition, there is no motivation or suggestion to combine the references. There is no suggestion in the references to combine the operations of a system that matches a credit card with a carrier and a printing system that generates magazines.

For at least these reasons, the combination of Hill '453 and Harris does not teach or suggest the subject matter of Claim 12. Accordingly, Claim 12 is allowable.

### VIII. CLAIMS APPENDIX

Pursuant to 37 C.F.R. § 41.37(c)(1)(viii), a copy of only the claims involved in the appeal should be included in this appendix. Accordingly, this appendix includes a copy of only the claims involved in the appeal. Canceled and withdrawn claims and their identification numbers are not included in this appendix.

1. A method comprising:  
writing electronic information to an optical disk on a binding line; and  
associating the written optical disk with a printed product on the binding line.
2. The method of claim 1 wherein the optical disk includes at least one of a CD, CD-ROM and DVD.
3. The method of claim 1 and further including printing personalized indicia on the printed product in response to what was written to the optical disk.
4. The method of claim 3 wherein the step of printing personalized indicia occurs after associating the optical disk with the printed product.
6. A method comprising:  
reading electronic information from an optical disk on a binding line; and  
associating the optical disk with a printed product on the binding line.

7. The method of claim 6 wherein the optical disk includes at least one of a CD, CD-ROM and DVD.

8. The method of claim 6 and further including printing personalized indicia on the printed product in response to what was read from the optical disk.

9. The method of claim 8 wherein the step of printing personalized indicia occurs after associating the optical disk with the printed product.

11. A method comprising:  
reading electronic information from an optical disk on a binding line wherein the optical disk has been electronically written offline with respect to the binding line; and  
associating the optical disk with a printed product on the binding line.

12. The method of claim 11 and further including printing personalized information on the printed product based on the information read from the optical disk.

13. The method of claim 11 and further including assembling the printed product based on the information read from the optical disk.

14. The method of claim 11 wherein the information read from the optical disk includes personalized information.

21. A method comprising:  
writing electronic information to an optical disk on a binding line;  
delivering a plurality of printed products to the binding line based upon the information written to the optical disk; and  
associating the printed product and the optical disk on the binding line.

22. A method comprising:  
reading electronic information from an optical disk on a binding line;  
delivering a plurality of printed products to the binding line based upon the information read from the optical disk; and  
associating the printed product and the optical disk on the binding line.

IX. EVIDENCE APPENDIX

Applicants' have not submitted evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon in this appeal.

X. RELATED PROCEEDINGS APPENDIX

As noted above in Section II of this Amended Appeal Brief, there are no related appeals or interference proceedings related to this application.

XI. CONCLUSION

In view of the foregoing, reversal of the final rejection of Claims 1-4, 6-9, 11-14, 21, and 22 and allowance of Claims 1-4, 6-9, 11-14, 21, and 22 are respectfully requested.

Respectfully submitted,



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